

# **EXHIBIT A**

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ECHOSTAR SATELLITE LLC AND  
10 ECHOSTAR TECHNOLOGIES CORPORATION

11 UNITED STATES DISTRICT COURT  
12 NORTHERN DISTRICT OF CALIFORNIA  
13 SAN JOSE DIVISION  
14

15 In re

16 ACACIA MEDIA TECHNOLOGIES  
17 CORPORATION  
18

Case No. 05-CV-1114 JW

**SATELLITE DEFENDANTS'  
MEMORANDUM RE THE  
DEFINITIONS OF TERMS IN  
CLAIMS 41-45 OF THE '992  
PATENT**

19 Date: June 2, 2006  
20 Time: 9:00 a.m.  
Courtroom: 8, 4th Floor  
21 Judge: Hon. James Ware  
22

1 Here, neither condition is present. As in *Microsoft*, the patentees' comments relate to the scope of  
2 the invention, as they viewed the invention in light of prior art, and not to any amendments in  
3 response to that prior art. See *Microsoft*, 357 F.3d at 1349 & n.5. In addition, the Ballantyne  
4 priority date, August 28, 1990, *pre-dates* the January 7, 1991, priority date of the '992 patent.  
5 Consideration of the '863's prosecution history is, therefore, both appropriate and consistent with  
6 the *Microsoft* decision.

7 The patentees' use of the phrase "one of the remote locations" in the '863 patent is  
8 consistent with their use of the phrase in the '992 patent. The patentees' explanation is also  
9 consistent with the common and ordinary meaning of the term "one." Like *Microsoft*, the Court  
10 should "take the patentee[s] at [their] word" and should not construe Claim 41 "more broadly  
11 than the patentee[s] clearly envisioned." *Id.* at 1350.

12 **IV. THE TERM "ITEMS' HAVING [OR CONTAINING] INFORMATION"**  
13 **SHOULD BE CONSTRUED TO MEAN "PHYSICAL OBJECTS ON WHICH**  
14 **INFORMATION IS STORED."**

15 In its *Markman I* Order, the Court construed the phrase "items containing information" to  
16 mean "items containing information in analog or digital form." The Satellite Defendants do not  
17 take issue with that construction, so far as it goes. But it has become apparent that there is an  
18 unanticipated ambiguity in that construction: the meaning of "item" as it is used in this phrase,  
19 which the Court did not construe.<sup>9</sup>

20 The Satellite Defendants propose that the term "items" having or containing information  
21 be construed to mean "physical objects on which information is stored, such as videotapes and  
22 laser disks." Acacia relies on a general dictionary and proposes that an item containing  
23 information is a "thing" containing information. But such a construction is so broad as to be  
24 meaningless.<sup>10</sup> Dictionary definitions of common words should not be used in place of the patent

25 <sup>9</sup> The Satellite Defendants have no objection, however, if the Court defers consideration of  
26 this term to the August 11, 2006 *Markman* hearing so that it may be heard in conjunction with  
27 issues raised by the Round 3 Defendants, who have indicated that they will seek a reconsideration  
28 of the phrase "items containing (or having) information."

<sup>10</sup> Acacia argues that "[t]he term 'item' is an example of a term in which the ordinary  
meaning, as understood by persons of ordinary skill in the art, should be readily apparent."  
Acacia's April 17, 2006, *Markman* Brief at 16. This argument is curious because Acacia, during  
(Footnote continues on next page.)

1 itself in defining claim terms. *See Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299  
2 (Fed. Cir. 1999). The Court cannot look at the meaning of a term in a vacuum; it must construe  
3 terms in the context of the intrinsic record. *See Phillips*, 415 F.3d at 1314. Here, the context  
4 dictates that “items having [or containing] information” should be defined as “physical objects on  
5 which information is stored.”

6 The ‘992 patent specification uses the term “item” in multiple ways, sometimes referring  
7 to physical objects, and sometimes referring to information. But here, where the claims are  
8 specifically describing items *that contain information*, the only logical conclusion is that the  
9 items are physical ones.

10  
11 **A. The Context of Claim 41 Requires Defendants’ Construction of “Items  
Having [or Containing] Information.”**

12 In the context of Claim 41, “items having information” are stored “*in a source material*  
13 *library*.” Thus, we turn to the relevant portion of the specification that defines “items” in that  
14 context:

15 Transmission system ... of the present invention ... includes source  
16 material library means for temporary storage of *items* prior to  
conversion and storage in a compressed data library....

17 As shown in FIG. 2a, the source material library means included in  
18 transmission system 100 preferably includes a source material  
19 library 111. The source material library 111 may include different  
20 types of materials including television programs, movies, audio  
21 recordings, still pictures, files, books, computer tapes, computer  
22 disks, documents of various sorts, musical instruments, and other  
23 physical objects. These materials are converted to or recorded on a  
media format compatible to the digital and analog inputs of the  
24 system prior to being compressed and stored in a compressed data  
library 118. The different media formats preferably include digital  
or analog audio and video tapes, laser disks, film images, optical  
disks, magnetic disks, computer tapes, disks and, [sic] cartridges.

25 ‘992 patent, 5:66-6:22.

26 (Footnote continued from previous page.)

27 *Markman I*, proposed that “item” should mean “units or members of a group or groups which  
28 have information.” Hymas Decl., Ex. P at 23. Thus, even Acacia concedes that there is no  
ordinary meaning of this term in the context of the Yurt patents.

1 The above quote teaches one skilled in the art that the source material library includes  
2 “different types of materials,” each of which is a physical object: “television programs, movies,  
3 audio recordings, still pictures, files, books, computer tapes, computer disks, documents of  
4 various sorts, musical instruments, and other physical objects.” Indeed, by specifying “other  
5 physical objects” at the end of this list, the patent makes it clear that all of the members of the list  
6 are physical objects. These items are then converted to or recorded on a media format that is  
7 compatible with the inputs of the transmission system, before the converted or recorded material  
8 is compressed and stored in a compressed data library. *Id.* Therefore, in the context of Claim 41,  
9 “items” in the source material library means “physical objects on which information is stored,  
10 such as videotapes or laser disks.”

11  
12 **B. Acacia’s Proposal to Define “Items” Having or Containing Information as a  
“Thing” is Unavailing.**

13 Acacia’s argument is essentially this: because the specification describes some items in  
14 the source material library that are not physical objects, “items” should not be limited to physical  
15 objects. Rather, “items” must be defined as “things.” The claims and the specification, however,  
16 do not support Acacia’s argument.

17 Acacia first contends that the specification states that “items” may be “analog and digital  
18 audio and video information.” Acacia’s April 17, 2006, *Markman* Brief at 19. But the portion of  
19 the specification Acacia relies on actually says “items *of* information may include analog and  
20 digital audio and video information.” ‘992 patent, 6:2-3 (emphasis added). There is a difference  
21 between “items *of* information” and “items containing [or having] information.” The former self-  
22 defines items as information; the latter must be different from the “information” in order to  
23 contain items.<sup>11</sup>

24  
25  
26 <sup>11</sup> Acacia’s argument is also contrary to the specification, which makes clear that the  
27 “source material library” is a place that can “include different types of materials,” ranging from  
28 books, to musical instruments, to video tapes. It is not a computer file server, which can only  
store digital information. It is a library, in the everyday sense of a physical place where media  
and other physical objects of many different types — not disembodied “information” — are kept.